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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/040,252	10/25/2001	Frederick M. Morgan	C01104/70092	3826

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EXAMINER

PHILOGENE, HAISSA

ART UNIT	PAPER NUMBER
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2821

DATE MAILED: 06/04/2003

11

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/040,252

Applicant(s)

MORGAN ET AL.

Examiner

Haissa Philogene

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13-16, 25-27 and 31 is/are rejected.
- 7) ☒ Claim(s) 12, 17-24 and 28-30 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 28 August 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- ☐ Interview Summary (PTO-413) Paper No(s). _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other:

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DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bailey et al., Patent No. 5,752,766, cited by Applicant.

Bailey discloses in Fig.2 an apparatus comprising a lighting fixture 12 including a light source which comprises an array of LEDs 22 capable of generating variable color radiation (see Col.1, lines 27-30), the lighting fixture adapted to be mounted on a surface 20 and having an inherent dimension when looked in the horizontal direction essentially normal to the surface 20 when the light fixture 12 is mounted on the surface 20. Bailey does not specifically disclose the dimension being less than a range of 0.5 to 2.5 inches. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have the dimension less than a range of 0.5 to 2.5 inches to allow a proper fit of the apparatus in any particular environment, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art.

Claim Rejections - 35 USC § 102

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 9-11, 13, 25-27 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Robbins, Patent No. 4,704,660.

As per claims 9-11, 13 and 31, Robbins discloses in Fig.1 an apparatus and method comprising: a lighting fixture (242-270) to generate variable color radiation provided by the radiation output of a light source 242 via light-transmitting members (260-270) to illuminate a liquid (water) contained in one of a pool and a spa 238, the lighting fixture adapted to be mounted on a portion of an inner surface 240 of the one of the pool and the spa 238, the inner surface 240 being at least partially in contact with the liquid (water); said lighting fixture comprising at least one mounting mechanism (see Fig.12) to mount the lighting fixture to the inner surface 240; said at least one mounting mechanism including at least one suction mechanism 300 to mount the lighting fixture to the inner surface.

As per claims 25-27, Robbins discloses the one of the pool and the spa 238 readable as having a range of typical liquid levels of the liquid (water) during use, and the light fixture via light-transmissive members (260-270) being adapted to be disposed below the range of typical liquid levels (as shown) or submersible in the liquid (water), said light-transmissive members readable as watertight lenses.

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Claims 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robbins in view of Hed, Patent No. 5,301,090, cited by Applicant.

Robbins discloses the claimed invention substantially as explained above except for the lighting fixture including at least one LED which includes at least two differently colored LEDs or at least one red LED, at least one green LED, and at least one blue LED. Hed discloses in Fig.2 an apparatus comprising a light fixture 20 including at least one LED which includes at least two differently colored LEDs or at least one red LED, at least one green LED, and at least one blue LED (items 24, 25 and 26). It would have been obvious to a person having ordinary skill in the art at the time the invention was made to employ the lighting fixture as taught by Hed into the Robbins type apparatus, because it would ensure a variable chromaticity luminaire for environmental modifications and/or decorative lighting purposes, thereby improving the efficacy of the apparatus.

Allowable Subject Matter

Claims 12, 17-24 and 28-30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The prior art fails to disclose the inner surface being formed from at least one magnetic material, and the at least one mounting mechanism including at least one magnetic mechanism to mount the lighting fixture to the inner surface (claim 12); the lighting fixture having a first dimension less than 2.5 inches which is essentially

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normal to the portion of the inner surface of the one of the pool and the spa when the lighting fixture is mounted on the portion of the inner surface (claim 17); the lighting fixture being adapted to be mounted on the portion of the inner surface such that the lighting fixture does not protrude through the portion of the inner surface (claim 28).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Micha, Patent No. 4,450,511, "Submersible high intensity lamp".

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Haissa Philogene whose telephone number is (703) 305-3485. The examiner can normally be reached on 6:30 A.M.-6:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on (703) 308-4856. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7722 for regular communications and after Final communications. The fax number for the examiner is (703) 746-4054.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

hp
June 1, 2003

Haissa Philogene
Primary Examiner

Haissa Philogene
AU 2821